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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,827	01/03/2002	Gary P. Morrison	TI-31373	4496

23494 7590 08/11/2004

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EXAMINER	
MITCHELL, JAMES M	

ART UNIT	PAPER NUMBER
2813	

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)	
	10/034,827	MORRISON ET AL.	
	Examiner	Art Unit	
	James M. Mitchell	2827	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

a) ☐ The period for reply expires _____months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.

2. ☐ The proposed amendment(s) will not be entered because:

   (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);

   (b) ☐ they raise the issue of new matter (see Note below);

   (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

   (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

5. ☒ The a)☐ affidavit, b)☐ exhibit, or c)☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: *See Continuation Sheet*.

6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

7. ☒ For purposes of Appeal, the proposed amendment(s) a)☒ will not be entered or b)☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:

   Claim(s) allowed: _____.

   Claim(s) objected to: _____.

   Claim(s) rejected: *2,4-10,12,15,17,18 and 23*.

   Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a)☐ approved or b)☐ disapproved by the Examiner.

9. ☐ Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. ☐ Other: _____

DAVID ZARNEKE
PRIMARY EXAMINER
8/9/04

Continuation of 5. does NOT place the application in condition for allowance because: applicant has not effectively established an earlier filiing date to overcome the cited prior art. M.P.E.P section 715.07 provides three ways pursuant to 37 CFR 1.131(b) to effectuate prior invention of the claimed subject matter. Since a 1.131 declaration is explicitly provided as a basis that evidence be submitted to establish prior inventorship, filing of a 1.132 declaration is ineffective, because it is used as evidence submitted to traverse the rejection or objection on a basis "otherwise provided for." Assuming that the declaration was appropriately filed under a 1.131 declaration or affidavit, it would still be ineffective since there would be no facts of record sufficient to show either (A) reduction to practice of the invention prior to the effective date of the reference; or B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or (C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

While applicant did submit a disclosure form, a date on its 2nd page does not appear to corroborate prior invention of the claimed subject matter. The date appears to indicate a submission to the "TI Patent DEPT " of either 2002 or 2003. Furthermore applicant's argument that a provisional application is proof that subject application "was ready for patenting" was an attempt to satisfy standards set forth in PFAFF v. Wells Electronics. Besides applicant's admission that priority was not granted under provisional application #60/258,525 (1st page) and that being"ready for patenting" is not the standard to enable applicant to swear behend a reference, PFAFF v. Wells Electronics is nonanalagous in that it dealt with the issue of infringement not this application's issue of the requirements needed to enable applicant to swear behind a reference .